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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,667	04/22/2004	Arnold Thaler	74104.105017	6830
86528	7590	09/16/2009		
King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701			EXAMINER KAMAL, SHAHID	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 09/16/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,667

Applicant(s)

THALER, ARNOLD

Examiner

SHAHID KAMAL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 21-37, 43-47, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 38-42 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-52 are currently pending and *1-20, 38-42 and 48-50 have been examined.*
2. Applicant's election without traverse of Group I (Claims *1-20, 38-42 and 48-50*), filed on May 26, 2009 is acknowledged.
3. Claims *21-37, 43-47, 51 and 52* are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected Invention, because there is no allowable generic or linking claim. Election was made without traverse.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims *1-20, 38-42 and 48-50* are rejected under 35 U.S.C. 102(e) as anticipated by Walter et al. (US Patent No. 6,246,995 B1) ("Walter").
6. Referring to claim 1, Walter discloses the following:
 - a) a product ("product or merchandise 12") having control circuits ("barcode 22") (see abstract, column 1, line 5 through column 2, line 7); and

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b) a verification and activation module coupled to the control circuits ("barcode 22") of the product ("product or merchandise 12"), wherein the verification and activation module activates the control circuits ("barcode 22") of the product ("product or merchandise 12") (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

7. Referring to claim 2, Walter further discloses wherein the verification and activation module is removably coupled to the product (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

8. Referring to claim 3, Walter further discloses wherein the control circuits of the product are deactivated when the verification and activation module is not coupled to the product (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

9. Referring to claim 4, Walter further discloses wherein the verification and activation module is programmed with information (see column 2, lines 31-67).

10. Referring to claim 5, Walter further discloses wherein the programmed information comprises purchase date and price of the product (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

11. Referring to claim 6, Walter further discloses wherein the programmed information comprises warranty information for the product (see column 1, line 5 through column 2, line 7,

column 2, lines 31-67).

12. Referring to claim 7, Walter further discloses wherein the programmed information comprises data about a consumer who purchased the product (see column 1, lines 38-62).

13. Referring to claim 8, Walter further discloses wherein the programmed information comprises data about a manufacturer of the product (see column 1, lines 38-62).

14. Referring to claim 9, Walter further discloses wherein the programmed information comprises data about the product (see column 1, lines 38-62).

15. Referring to claim 10, Walter further discloses wherein the verification and activation module comprises a non-volatile programmable memory (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

16. Referring to claim 11, Walter further discloses wherein the non-volatile memory is selected from the group consisting of electrically erasable and programmable read only memory (EEPROM), Flash memory and battery backed-up random access memory (RAM) (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

17. Referring to claim 12, Walter further discloses wherein the product comprises verification and activation circuits (see column 1, line 5 through column 2, line 7, column 2,

lines 31-67).

18. Referring to claim 13, Walter further discloses wherein the verification and activation module comprises a non-volatile programmable memory, and verification and activation circuits (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

19. Referring to claim 14, Walter further discloses a security feature that deactivates the product when outside of a geographical location (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

20. Referring to claim 15, Walter further discloses a security feature that deactivates the product when a security signal is not present (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

21. Referring to claim 16, Walter further discloses wherein warranty history of the product is stored in the non-volatile memory (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

22. Referring to claim 17, Walter further discloses wherein repair history of the product is stored in the non-volatile memory (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).

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23. Referring to claim 18, Walter further discloses wherein maintenance history of the product is stored in the non-volatile memory (see column 1, line 5 through column 2, line 7, column 2, lines 31-67).
24. Referring to claim 19, Walter further discloses a communications interface coupled to the verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).
25. Referring to claim 20, Walter further discloses wherein the communications interface is selected from the group consisting of WIFI and Bluetooth (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).
26. Referring to claim 38, Walter discloses the following:
- c) an original product (see abstract, column 1, line 5 through column 2, line 7);
 - d) a verification and activation module coupled to the original product (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67); and
 - e) a replacement product, wherein when the verification and activation module is removed from the original product and coupled to the replacement product, the replacement product is enabled for operation and the original product is disabled from operation (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

27. Referring to claim 39, Walter further discloses wherein once the replacement product has been enabled for operation by the verification and activation module, the original product cannot be enabled again by the verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

28. Referring to claim 40, Walter discloses the following:

- f) an original product having a first verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67); and
- g) a replacement product having a second verification and activation module, wherein when the first verification and activation module is in communication with the second verification and activation module, the replacement product is enabled for operation and the original product is disabled from operation (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

29. Referring to claim 41, Walter further discloses wherein the communication is wireless (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

30. Referring to claim 42, Walter further discloses wherein the communication is by wire (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

31. Referring to claim 48, Walter discloses the following:

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- h) providing an original product having a verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67);
- i) providing a replacement product (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67); and
- j) removing the verification and activation module from the original product; and installing the verification and activation module in the replacement product, wherein the replacement product is enabled for operation and the original product is disabled from operation (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

32. Referring to claim 49, Walter discloses the following:

- k) providing an original product having a first verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67);
- l) providing a replacement product having a second verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67); and
- m) communicating between the first and second verification and activation modules such that the replacement product is enabled for operation and the original product is disabled from operation (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

33. Referring to claim 50, Walter discloses the following:

- n) providing a product having a verification and activation module (see abstract, column 1, line 5 through column 2, line 7); and

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o) communicating with the verification and activation module such that the product is enabled for operation when a correct security code is communicated to the verification and activation module (see figure 1, abstract, column 1, line 5 through column 2, line 7, column 2, lines 31-67).

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

35. Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (8:30am -7:00pm), Friday off.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

38. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

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39. Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Sk
September 10, 2009

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621